

## **REMARKS/ARGUMENTS**

The Office Action mailed December 8, 2004 has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested.

### Claim Status and Amendment to the Claims

Claims 1-24 are now pending. No claims stand allowed.

Claims 1, 7, 9, 12, 15-16 and 20-21 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. The amendment also contains minor changes of a clerical nature.

New claims 22-24 have been added, which also particularly point out and distinctly claim subject matter regarded as the invention. Support for these claims may be found in the specification, page 3, the last line to page 4, line 3 (paragraph [0012]).

No "new matter" has been added by the amendment.

### Claim Objections

Claims 7, 15, 16, 20 and 21 stand objected to for minor informalities as noted in the Office Action.

The claims have been amended in accordance with the Examiner's suggestion. With this amendment, withdrawal of the objection to the claims is respectfully requested.

### The 35 U.S.C. §112 Rejection, Second Paragraph

Claims 12 and 13 stand rejected under 35 U.S.C. §112, second paragraph, as

being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention.

Claim 12 has been amended to recite “are configured to be” in place of “can be.” With this amendment it is respectfully submitted the claims satisfy the statutory requirements.

The 35 U.S.C. §102 Rejection

Claims 1-21 stand rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Rossmann (U.S. Pat. No. 6,430,409), among which claims 1, 9 and 16 are independent claims. This rejection is respectfully traversed.

**A. Patentability of the Claims**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 869 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). *See also*, M.P.E.P. §2131.

In the Office Action, the Examiner alleges that the elements of the presently claimed invention are disclosed in Rossmann. The Examiner specifically equates Rossmann’s cell phones with the claimed modem units, Rossmann’s “messages” sent to cell phones with the claimed status checks (status check messages), and Rossmann’s

“response from cell phone” with the claimed reply from the modem units. The Applicants respectfully disagree for the reasons set forth below.

Claim 1 recites a system comprising (a) a computer operably connected to a network, the computer having software configured to track the status of multiple modem units, the software allowing for the production of *status checks* to be sent to the multiple modem units, and (b) modem units configured to receive *status check message*, the modem units being associated with host processors, the modem units being configured to reply with *status information* without being controlled by the host processors, as amended (*emphasis added*).

Rossmann relates to two-way data communication devices such as cellular telephones that permit a user to interface and interact with a server on a computer network (column 1, lines 31-34 thereof). In Rossmann, a user (client module in the data communication device) transmits a message to a server, and the server processes the message and transmits a response to the user’s data communication device (column 4, lines 34-45 thereof). The client module interprets (processes) the response and generates a user interface which allows the user to further communicate with the server, for example, to input data, retrieve data, or store information (column 4, line 46- column 5, line 54 of Rossmann). Thus, in Rossmann, the alleged “message” sent to the client module (cell phone) is a *reply* responding to the original messaged form the user. Such a reply is no way a status check to track the status of the user’s cell phone (the alleged modem unit). In essence, Rossmann merely discloses a client-server system for

mobile data communication devices and a server on a computer network, and fails to teach or suggest performing any status check for such data communication devices.

Furthermore, Rossmann's wireless mobile telephone has a processor, and the client module of the mobile telephone executes on that processor (column 48, lines 18 and 31 thereof). Therefore, Rossmann also fails to disclose, teach, or suggest client modules (the alleged modem units) being configured to reply without being controlled by the host processors, as recited in Claim 1.

Claims 9 and 16, as amended, also include substantially the same distinctive feature as claim 1.

Accordingly, it is respectfully requested that the rejection of claims based on Rossmann be withdrawn. In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Dependent Claims

Claims 2-8 depend from claim 1, Claims 10-15 depend from claim 9, and Claims 17-21 depend from claim 16, and thus include the limitations of the respective independent claims. The argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable at least for the same reasons.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

**B. Regarding *In re Hutchison***

In the Office Action, the Examiner cites *In re Hutchison* and alleges as follows:

The applicant should note that the claims have been interpreted with the condition that it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. (Office Action, page 3, lection 5).

The applicant respectfully disagrees about interpretation and applicability of *In re Hutchison* for the reasons set forth below.

The *Hutchison* Court, which decided in 1946, stated as follows:

[4] Taking first claim 42 for analysis and comparing it principally with the Moxon patent, the first phraseology italicized by appellant is the introductory clause to the effect that the laminated article is “*adapted*” for use in making a template or the like. This does not constitute a limitation in any patentable sense, but if it were in that category, it is anticipated by Moxon who teaches that his laminated sheet (made up of layers of paper and metal, united by an adhesive) may be used in making a template. [Emphasis original]

Claim 42 cited in *In re Hutchison* reads as follows:

42. As an article of manufacture, adapted for use in the fabrication of a metal template or the like suitable for metal-working operations, a laminated unit comprising a backing element surface with paper having an exposed outer surface to receive the template design, said backing element being composed of metal stock possessing the requisite thickness and rigidity to become the finished template and capable of being machined under heat generating conditions in accordance with the template design, and said surfacing paper being bonded to the metal backing element by a water-proof heat-set and heat-resistant adhesive which renders the paper immune from plane dimensional variations resulting from changes in atmospheric moisture, and said adhesive

being set under temperature and time conditions which produce a bond between the surfacing paper and the metal backing element that is unaffected by the heat generated during said template machining operations, the heat-resistant temperature of the heat-set adhesive being well above 212 [degrees] F.

Accordingly, in *In re Hutchison*, (i) the word "adapted" was used in the preamble ("introductory clause") of the claim reciting an article of manufacture, and (ii) the word "adapted" was used in a phrase "adapted for use in the fabrication" which was merely a statement of use.

The case laws with respect to the Effect of Preamble have been well developed, and their holdings are cited in the MPEP as follows:

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation").

#### MPEP § 111.02 Effect of Preamble

Thus, the reason why the *Hutchison* court held that the statement ("the laminated article is 'adapted' for use in making a template or the like") does not constitute a limitation in any patentable sense was because the statement was in "the introductory

clause" (i.e., the preamble) and "merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations," not because the limitation was recited as an element "adapted to perform a function" as the Examiner alleges. It should be noted that the body of claim 42, as recited above, "fully and intrinsically sets forth all of the limitations of the claimed invention" and thus the case held by the *Hutchison* court was exactly the same as that before the *Pitney Bowes* court.

In addition, it should be noted that the subject matter of claim 42 is an article of manufacture which cannot perform an operation or function. The holding of the *Hutchison* court is limited to a statement of use in the preamble, and does not apply to the functional or operative limitation to an element recited in the body of an apparatus claim. The *Hutchison* court neither decided nor stated that "the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform and that it does not constitute a limitation in any patentable sense," as the Examiner alleges.

Accordingly, it is respectfully submitted that the Examiner's allegation regarding *In re Hutchinson* is incorrect, and that the *Hutchison* court's decision should not be applied to the present case.

Conclusion

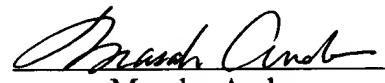
It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-1698.

Respectfully submitted,  
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Dated: March 8, 2005



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Limited Recognition under 37 CFR §10.9(b)

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